

II. REMARKS

Applicant offers the following remarks in response to the Final Office Action dated January 21, 2010.

A. STATUS SUMMARY

Claims 37-72 are pending in the present application. Claims 1-36 have been previously cancelled without prejudice. No claims have been added. Accordingly, claims 37-72 remain pending.

In this Amendment, Applicant has amended claim 37. Applicant is not conceding that the subject matter encompassed by claim 37 prior to this Amendment is not patentable over the art cited by the Examiner. Claim 37 was amended solely to facilitate expeditious prosecution of the present application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claim 37 as presented prior to this Amendment and additional claims in one or more continuing applications. Applicant believes the amendment to claim 37 is supported by the application as filed and that no new matter has been added.

B. ALLOWABLE SUBJECT MATTER

Applicant appreciates Examiner Park's indication that claims 37-72 would be allowed if rewritten or amended to overcome the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph. Applicant has made certain amendments and discusses these rejections below. Applicant believes that claims 37-72 are in condition for allowance and notice of the same is respectfully requested at the earliest possible date.

C. CLAIM REJECTIONS – 35 U.S.C. § 101

Claims 37-60 were rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. Applicant respectfully traverses.

The independent claims are claims 37 and 49. Applicant has amended claim 37 to recite a “computing device.” This amendment is believed fully supported by the application as originally filed and that no new matter has been added. Accordingly, the rejection of claim 37 and its dependent claims should be withdrawn.

Regarding claim 49, the Patent Office alleges that Applicant’s claimed computer program product comprising a computer readable storage medium fails to establish a statutory category of invention. (Final Office Action dated January 21, 2010, page 2). The Patent Office then suggests amendment to recite “non-transitory” in association with the computer readable storage medium. (*Id.* at page 3).

However, the Patent Office has cited no authority for its position that Applicant’s claimed computer program product comprising a computer readable storage medium fails to establish a statutory category. Further, Applicant finds that the bare allegation of the Patent Office that Applicant’s claimed computer readable storage medium “could be one of the non-statutory categories” fails to provide adequate legal or technical foundation to form a proper rejection to which Applicant may formally respond.

As such, the present rejection is in error and is defective on its face. Accordingly, Applicant respectfully requests that the present rejection of claim 49 and its dependent claims be withdrawn for at least this reason.

Additionally, Applicant notes that Director Kappos has, per Applicant's understanding by memorandum, authorized Examiner's to allow amendment to recite "non-transitory" where a Specification lacks explicit support for the same. However, it is Applicant's understanding that this authorization was provided to assist applicants that did not have support for or claim a "storage" medium as part of a computer program product claim.

Applicant respectfully submits that it claims a computer readable storage medium in association with its claimed computer program product, and that this claimed subject matter is statutory. As such, Applicant believes that this authorization does not apply to Applicant's claims.

The Patent Office is further respectfully reminded that "[w]hen a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim." (as referenced in the Guidelines to Subject Matter Eligibility - OG Date: 22 November 2005). Further, "[p]roduct claims are claims that are directed to either machines, manufactures or compositions of matter." *Id.* Applicant respectfully submits that its claimed subject matter should be treated properly as a statutory product claim.

Further, Applicant is not aware of any authority that requires such an amendment to recite "non-transitory" where an applicant already claims a "storage" medium. Applicant respectfully submits that a storage medium adequately distinguishes and claims subject matter in association with a statutory class comprising a computer program product. As such, Applicant's claim 49 and its dependent claims are already directed to statutory subject matter. Accordingly,

Applicant respectfully submits that the present rejection of claim 49 and its dependent claims be should be withdrawn.

Applicant respectfully submits that claims 37-60 are directed to statutory subject matter and that the rejection of claims 37-60 under 35 U.S.C. § 101 should be withdrawn.

D. CLAIM REJECTIONS – 35 U.S.C. § 112

Claims 37-72 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully traverses.

The Patent Office alleges that Applicant's claimed subject matter was not described in such a way as to reasonably convey that Applicant was in possession of the claimed subject matter. (Final Office Action dated January 21, 2010, page 3). However, the Patent Office is respectfully reminded that the Federal Circuit has long held that the written description need not provide *ipsis verbis* support of claim terms. As stated in *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ.2d 1578, 1584 (Fed. Cir. 1996):

If . . . the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. *Id.* at 1175. If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met. *Id.*

Thus, for any rejection to stand under 35 U.S.C. 112, first paragraph, the Patent Office must, in order to meet the burden of proof, provide reasons why one of ordinary skill in the art

would not consider the description sufficient. Further, a claim term does not have to be included *ipsis verbis* in the Specification in order to meet the written description requirement.

In the present rejection, the Patent Office has not provided any reasoning at all as to why it believes a person of ordinary skill would not consider the description sufficient. Because the Patent Office has not provided any reasoning, Applicant respectfully submits that the Patent Office has not met its burden.

Further, because *ipsis verbis* language support is not required, Applicant respectfully submits that it may use terminology that differs from terminology used in the Specification as long as a person of ordinary skill would understand that Applicant had possession of the claimed subject matter at the time of filing.

Regarding possession, the Patent Office is respectfully reminded that “to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed.” (MPEP 2163.02 citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), emphasis added).

Further, “[t]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’ ” (MPEP 2163.02 quoting *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985))

(quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983), emphasis added).

Applicant respectfully submits that its Specification meets both requirements of “reasonably conveying” with “reasonable clarity” possession of the claimed subject matter at the time of filing.

Further, “[a] description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.” (*Id.* citing See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971), emphasis added). “The examiner, therefore, must have a reasonable basis to challenge adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (MPEP 2163.04 citing *Wertheim*, 541 F.2d at 263, 191 USPQ at 97, emphasis added).

Because the Patent Office has provided no reasoning to support its allegations, Applicant’s Specification is presumed sufficient and the present rejection is in error. Applicant further respectfully submits that the Patent Office has not shown that it has a reasonable basis to challenge adequacy of Applicant’s written description.

The Patent Office has alleged that certain specific phrases of Applicant’s claims were not described in the original specification. (Final Office Action dated January 21, 2010, page 3). While Applicant believes that the Patent Office has not met its burden of proof beyond a preponderance of the evidence, and that Applicant has no burden of presentment, Applicant

provides the following examples to expedite prosecution. Applicant further reiterates that *ipsis verbis* support for claim language is not required.

The allegedly unsupported phrase “collaborative information” is recited at least in paragraph [0017] of Applicant’s Specification as published. The phrase “collaborative primitives” is recited at least within Figure 6 and paragraph [0112] of the Specification as published. The allegedly unsupported phrase “message data model” is recited at least in paragraph [0108] of Applicant’s Specification as published. The allegedly unsupported phrase “message exchange sequence” is recited at least in paragraph [0111] and paragraph [0114] of Applicant’s Specification as published. The allegedly unsupported phrase “initiating the first common primitive message exchange sequence” is supported at least in Figure 5 and paragraph [0105] through paragraph [0108] of Applicant’s Specification as published. The allegedly unsupported phrase “receiving a second annotated message” is supported at least in paragraph [0109] of Applicant’s Specification as published. Additional examples may be found throughout the application as filed.

Applicant respectfully submits that its application as filed reasonably conveys with the required reasonable degree of clarity Applicant’s claimed subject matter. Additionally, Applicant respectfully submits that a person of ordinary skill in the art would understand that Applicant was in possession of Applicant’s claimed subject matter at the time of filing the present application. Applicant further respectfully submits that a person of ordinary skill would understand, based upon Applicant’s teachings, that Applicant’s Specification adequately discloses what is claimed.

Application Serial No.: 10/665,699
Docket No.: SOM920030006US1
Response to Final Office Action Dated: January 21, 2010
Response Dated: April 14, 2010

Therefore, Applicant respectfully requests that the rejection of claims 37-72 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Applicant respectfully submits that claims 37-72 are in condition for allowance and notice of the same is requested at the earliest possible date. Applicant reserves the right to provide additional arguments against the rejection of these claims in the future if needed. In view of the above, reconsideration and allowance are respectfully requested.

III. CONCLUSION

In light of the above Amendments and Remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Office Action.

Although it is believed that the appropriate fees are submitted with this transmittal, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 09-0461.

Respectfully submitted,

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Date: April 14, 2010

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